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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/720,927

10/04/1996

ASHER GIL

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919 7590 06/26/2007

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/720,927

Applicant(s)

GIL ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,10,13,14,16 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,10,13,14,16 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 3/26/07 has been entered. The examiner will address applicant's arguments and comments at the end of the office action.

1. Claims 1,5,6,8,10,13,14,16,19-26, are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (5313404).

For claims 1,5,8,10,13,14,16,19-26, Wu discloses an automatic postal machine that accepts items for storage and for pick up by a commercial carrier. The machine has an outer housing, which is the outer walls of the machine itself. The means for weighing an item is the weighing scale 500. The means for inputting information relating to the destination of the item from the customer is the keyboard of buttons 70 on the front of the machine. One of the buttons is 79, which is a domestic mail button. When this button is pressed, this is a step of inputting information that indicates that the mail is domestic, which is information relating to the destination of the item. Domestic mail is bound for inside the US, which is a destination for the item. The same holds true for the "air mail" button, which is traditionally associated with overseas mail, which is a destination. Additionally, it is disclosed in column 1, lines 62-end, that the machine can automatically print out the ZIP codes on the mail items according to "the input ZIP codes". Wu discloses a means for inputting information relating to the destination of the item. The control means for calculating shipping charges is the microprocessor that is disclosed in column 4, lines 41-44 as calculating shipping charges. The control means is in communication with the weighing means and the inputting means. The shipping fee that is calculated is based on the weight of the item and the class of

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service, which can be domestic mail (info. relating to a destination). The means for accepting identification information is the money card reader 711 that is disclosed in column 4, lines 4-9. Applicant has claimed that the means for accepting identification information relating to eventual payment from the customer comprises a means for receiving and reading a credit card. The examiner notes that the structure defined by this language is the same as found in Wu's money card reader 711. The structure is the same. The means for communicating the charges to a central location for billing the charges is satisfied by the disclosure in column 3, lines 65 to column 4, line 3, where it is disclosed that a modem 151 may be added to the system so that data communication with a remote host 150 can occur. This disclosure satisfies the claimed means plus function language. This inherently was done via telephone lines. The examiner wants to note that the act of communicating the charges information to a central location for the billing is not part of the claim, only the structure that is used to accomplish this step. The intended use of the communication means does not define over the prior art because the prior art is fully capable of doing what is claimed due to the fact that there is a modem present that can communication with the remote host 150. The storage area is defined by a 1st zone 162 and a secure zone 161 that the item is moved into for storage. Wu discloses the invention as claimed.

For claims 5,10,16,19,21,22,25,26, in addition to that disclosed above, the means for storing the information associated with the item is satisfied by the disclosure in column 5, lines 3-7, where it is disclosed that payment data of the mail is stored in the

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microprocessor. This inherently requires a storage device of some kind (memory) which satisfies what is claimed.

For claims 6,16,26, the means for printing a hard copy of a manifest (or the means for printing a hard copy of the shipment fee in claim 16) is the printer, that is disclosed in column 5, lines 3-7 as being capable of printing out the payment data that is stored by the microprocessor. The means for printing is a printer, which is disclosed in Wu.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5313404) in view of Takesako (4641239).

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For claim 2, Wu does not disclose a means for supplying voice instructions for operation of the system as claimed. Takesako discloses an automated banking machine that has a voice instruction unit 17, that supplies instructions to the user of the automated machine on how to operate the machine. The instruction unit includes a speaker to emit the audible instructions. This is present so that users who are not familiar with the operation of the machine can get some guidance on how it works. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Wu with a voice instruction unit as disclosed by Takesako, so that instructions on how to use the postal machine can be given out to users who may not know how to operate the machine. One of ordinary skill in the art would have been motivated to do this because of the fact that many users may not know how to operate the machine and would need some instructions on its operation.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5313404) in view of Stringer (5042015).

For claim 4, not disclosed is a means for measuring the item size and inputting the size into the control means for use is calculating a shipping charge. Stringer discloses a system that is intended to measure the dimensions and volume of a package that is to be shipped. It is disclosed in column 1 that many shippers calculate shipping charges based on both package weight and package dimensions. This is well known in the art as "dimensional weight". Stringer discloses a system that allows the dimensions of a package to be determined for use in calculating a shipping charge.

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Because it is known that many shipping companies calculate shipping charges based on both package weight and package dimensions, one of ordinary skill in the art would have been motivated to provide the system of Wu with the ability to measure the item size and input that size into the control means so that the control means can calculate shipping charges by weight and volume (i.e. well known dimensional weight).

6. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. This is a rule 105 requirement for information, see MPEP 704.

In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention.

The Zipster (the alleged prototype) was stated as being "designed specifically to meet the needs of the USPS in implementing **their program** for automating the postal services", from what is believed to be appendix C, page 2, under "Overview". Also in this document it is disclosed "The Zipster will not only overcome **the problems outlined in the Office of Technology Assessment (OTA), Review of Postal Automation Strategy**", page 2, 2nd paragraph. On page 2, paragraph 5 discloses "One of the **options mentioned in the OTA review**". It appears to the examiner that the Zipster was in part designed in response to this OTA document and possibly others. The examiner feels

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that this information is required for the proper examination of this application. The examiner is interested in finding out what the OTA document discloses as well as the content of any other documents that were relied upon to develop the invention of applicant. What were the "needs" that the document set forth the USPS as needing? What was the USPS automation program comprised of? What were the options that were mentioned in the OTA review? This kind of information is material to the examination of the instant application because it appears that there is possible prior art from the USPS that may have a material affect on the patentability of the pending claims. If the USPS OTA review document stated that the post office needs an unmanned package station where packages can be weighed and shipping fees assessed, the examiner must take this into account in determining what the inventors actually invented and in considering any obviousness issues under 35 USC 103 in view of these documents. If the USPS said they needed a system to do A, B, and C, and the claims are reciting means language that simply does A, B, and C, then the examiner must take this into consideration during the prosecution of this application. The evidence submitted with the 131 declarations introduce into the prosecution record the fact that the Zipster was designed to meet the needs of the USPS that were set forth in a USPS document (the OTA review). The examiner needs to see this document as well as any other documents that the inventors took into consideration when developing the Zipster. Any and all documents that the applicant used to develop their invention should be submitted to the examiner. For each publication, please provide a concise

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explanation of the reliance placed on that publication in the development of the disclosed subject matter.

7. Applicant's arguments filed 3/26/07 have been fully considered but they are not persuasive.

Applicant has submitted two declarations under 37 CFR 1.131. The examiner does not find the declarations and the accompanying evidence to be a persuasive showing of fact; consequently the 131 declarations are found to be insufficient to overcome the reference to Wu (5313404). The reasoning is as follows.

There are some issues that applicant should correct that appear to be informal in nature, but need to be corrected. The examiner notes that none of the evidence that was submitted for review was actually labeled as Appendix B, C, D, E, or F. The examiner requests that applicant label each page of each appendix so that it is clear which one is which. Also, the examiner notes that the declarations state that an Exhibit B and F were submitted (B allegedly being the Wu reference; unclear what the appendix F is) but neither was submitted. The declarations are referring to appendices that were not provided to the examiner. Also, the date listed in number 3 does not appear to be correct. Application 07/678,863 was filed on April 1, 1991, not in the year 2001. These issues appear to be informalities but should be corrected in any future submission under 37 CFR 1.131, especially the dates and missing appendices.

With respect to the evidence submitted and the statements in the declaration by the inventors, they are not seen as being persuasive.

With respect to what is believed to be appendix D, the examiner does not feel that this document can be accepted as evidence at this time. Further clarification may be required to as to what is meant by the statement on page 2 that reads “Zipsters (***patent pending***) employ the latest...”. Applicant is apparently submitting this evidence to show an actual reduction to practice (“*the subject matter contained in at least each claim rejected above was actually reduced to practice prior to the earliest effective date of the Wu reference*”, taken from attorney comment on page 19 of the most recent response). The language “*patent pending*” is well known to mean that the applicant has filed a patent application for their invention with the USPTO. If this document is supposed to be evidence of the Zipster (as claimed) being in the possession of the inventors as of 6/11/1990, and the invention is referred to as being “patent pending”, the earliest effective US filing date for the instant patent application is the filing date of 07/678,863, which is 4/1/1991. If the Zipster was “patent pending” when the document was written or disseminated, the examiner then questions if this document is actually evidence that goes back to 6/11/1990 because applicant does not appear to have been “patent pending” until 1991. At this time, until the issue of what is meant by “patent pending” is clarified or resolved, the examiner does not feel that this document can be considered as evidence. Applicant filed their earliest patent application 4/1/1991, so if the document states that the Zipster was patent pending, then this must reasonably be taken to mean that this document was generated after the filing of 07/678,863, which means that this document can reasonably be seen as having a date after 4/1/1991. This may not be correct but this issue needs to be addressed before the examiner will

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take the evidence into further consideration. In this case, the examiner believes the document itself calls into question the actual date for this document. The term "patent pending" seems to contradict with the statements that this evidence has a date prior to 6/11/1990.

With respect to appendix E, the examiner notes that most of the drawings submitted as evidence have dates that are after 6/11/1990. Both inventors have stated in # 10 of the declarations that *"While at least some of the drawings in Exhibit E are dated after June 11, 1990, they are all representative of the pre-Jun 11, 1990 prototype."* The examiner cannot accept the drawings with dates after 6/11/1990 unless applicant provides more evidence or more information concerning this appendix. Because of the fact that the majority of the drawings in Appendix E have dates that are after 6/11/1990, a reasonable examiner must be concerned about the dates. The statement by the inventors that the drawings with dates after 6/11/1990 are *"representative of a pre 6/11/1990 prototype"* is too vague and non-specific to be able to be accepted as a persuasive showing of fact. In what manner are the submitted drawings (with post 6/11/1990 dates) representative of the pre 6/11/1990 prototype? Representative in aesthetics only? Representative for the outer housing shape only? If the submitted drawings are stated to be "representative", this has to be taken as meaning that the drawings do not show the same as what was in existence prior to 6/11/1990, because they are "representative" of the prototype. In what manner are these drawings representative of a pre 6/11/1990 prototype? This is one thing that the examiner feels must be explained further. From MPEP 715.07, *"A 131 declaration must*

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clearly explain which facts or data applicant is relying on to show completion of the invention prior to a particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and thus does not satisfy the requirement of 37 CFR 1.131(b)." The

inventors have not explained to what extent the submitted drawings are being relied upon to show pre 6/11/1990 prototype features. Additionally, if the inventors had a working prototype before 6/11/1990 (had reduced it to practice before 6/11/1990 as applicant's counsel has argued), and the inventors are going to rely upon drawings with dates after 6/11/1990 to show reduction to practice, then a detailed explanation as to why there is no other evidence must be provided. Surely if a working prototype was in existence prior to 6/11/1990, there must be some other evidence in the form of photos or notes or something. It is hard to accept that the inventors had a working prototype prior to 6/11/1990, but mostly have submitted drawings dated after 6/11/1990. A reasonable person would assume that the drawings for any prototype would need to come before the prototype could even be made. You don't usually build the prototype then have the drawings made. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. From *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890), the court stated that

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"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others."

In the declarations, is the statement of number 7 to be taken as a statement from the inventors that the invention was actually reduced to practice prior to 6/11/1990? The examiner notes that applicant's counsel has argued that the invention has been shown to be reduced to practice, but the inventors never actually declare this fact themselves.

The examiner notes that the 131 declarations both mention an Appendix F in the section number 13, where the claim limitations are addressed with respect to the submitted evidence. There is no appendix F that the examiner can find. The examiner cannot take into consideration evidence that has not submitted.

With respect to the section of the declarations that detail how a pre 6/11/1990 prototype meets every limitation of the claims, it is not persuasive. Any of the pages referred to in appendix E that have dates after 6/11/1990 have not been considered as valid evidence at this time. The reliance on these pages of Appendix E is not persuasive. With respect to the fact that applicant mostly refers the examiner to an entire page in the documents, this is not seen as satisfying the responsibility the

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inventors have to clearly explain what facts are being relied upon. As an example, what portion of page 7 in exhibit C is being relied upon for Claim Recitations UVWX? This is not clear. Applicant must clearly explain what language from page 7 is being relied upon and must clearly explain how it provides support for the corresponding claim limitations. This has not been done. Applicant has the burden of the showing of proof; the examiner should not have to try to figure out what is meant by a general referral to an entire page of a document. Applicant needs to be more clear and provide more of an explanation.

Due to missing appendices, drawing pages with questionable dates, an exhibit that mentions "patent pending" with respect to the invention as claimed, and due to vague and non-specific statements in support of a showing of fact, the examiner finds the submitted evidence and the 131 declarations to be non-persuasive. The 131 declarations are found to be insufficient to overcome the reference to Wu (5313404).

With respect to the 102 rejection in view of Wu, the only argument for patentability is the reliance on the 131 declarations, which are not persuasive. The 102 rejection is deemed to be proper because applicant did not present any arguments stating that the rejection is in error. Applicant is simply trying to remove Wu as a usable reference via 37 CFR 1.131 and the examiner notes that applicant never actually stated that the 102 rejection itself is in error. The rejection will be maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

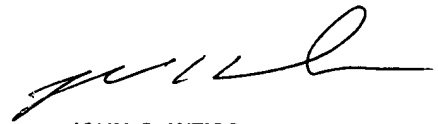
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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